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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,148	04/15/2004	Klaus Schippl	979-062	8759
7590 11/15/2005				
SOFER & HAROUN, L.L.P. 317 Madison Avenue, Suite 910 New York, NY 10017				
			EXAMINER NGUYEN, DONGHAI D	
			ART UNIT 3729	PAPER NUMBER

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

rnta

Office Action Summary	Application No. 10/826,148	Applicant(s) SCHIPPL, KLAUS	
	Examiner Donghai D. Nguyen	Art Unit 3729	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1. ☒ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the reference numbers, letters and symbols are hand written and not uniformly thick and well defined. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure should be modified to read on the method invention without repeat the claims and the abstract must not exceed 150 words in length. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities:

There are not subtitles or headline for each section of the specification. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR
DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A
COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05).
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97
and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) “the longitudinal tube” (claim 5, line 7) lacks antecedent basis.

b) claim directed to a method however in the body of claim directed to the product formed such as “the superconductor cable consisting of the cable core and the corrugated tube” (see claim 5, line 9) is product limitation which does not seem to further define the method as claimed in the claims. The following step are suggested: “continuously pulling the cable core from a supply unit; continuously forming a slotted tube around the cable core with the metal strip and welding shut the slotted tube; then corrugating the welded tube with the cable core inside the tube, where the inside diameter of the corrugated tube is larger than the outside diameter of the cable core to form a semi-finished superconducting cable; winding the semi-finished superconducting cable on a cable drum or coiling the semi-finished superconducting cable in at least one turn; etc.” in order to positively recited the method invention.

c) “the cable” (claim 5, line 12) is unclear as to whether it is the same as the superconducting cable as presented in the preamble of claim 5.

d) "at least 0.25%" (claim 7, lines 1-2) is vague and indefinite since it is unknown as to whether this is an upper or a lower limitation and what is the range of the exceed length. Further "0.25%" should have been: --0.25% of the original length of the cable core--.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,718,618 to Hirose et al.

Regarding claims 5 and 8, Hirose et al disclose a process for the production of a superconducting cable having a cable core, which contains at least one elongated superconducting element, and a flexible tube, which surrounds the cable core, said process comprising the steps of: the cable core (with high temperature superconductor 6 see Fig. 1) is pulled continuously from a supply unit (See Fig. 2); a metal strip (20) is pulled continuously from a strip supply unit (See Fig. 4); the metal strip is formed continuously around the cable core to form a slotted tube (see Fig. 4); the longitudinal slot is welded shut (by welder 21); and then the welded tube is corrugated (by corrugators 22), where the inside diameter of the corrugated tube is larger than the outside diameter of the cable core (See Fig. 4); the superconducting cable consisting of the cable core and the corrugated tube is wound up on a cable drum (23); and the ends of the cable core are then mechanically joined to the ends of the corrugated tube while the

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cable is on the cable drum (See, Col. 3, lines 63-65). Hirose et al is silent about the at least one turns of the cable is wound up on the drum (23). Regarding to this, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to at least wind one turn of the cable around the cable drum as per specific manufacturing requirements purpose since applicant has not disclosed that the winding of at least one turn on the cable drum as recited in the claims, is for a particular purpose or provides an advantage and it appears that the invention would perform equally well with substantially one turn as partially shown in the Fig. 4 of Hirose et al.

Regarding claims 6 and 7, Hirose et al teach the slack or the exceed length of the core cable being configuration base on its lengths (see Col. 4, lines 31-40). Regarding the configuration of 0.25%, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have configured the forming cable core into the tube in such a way such that the exceed length is being at least 0.25% of its original length.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art reference cited for their teaching of manufacturing superconductive cable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (571)-272-4566. The examiner can normally be reached on Monday-Friday (9:00-6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571)-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN
October 28, 2005


MINH TRINH
PRIMARY EXAMINER